

### **REMARKS/ARGUMENTS**

Reexamination and reconsideration of this application, withdrawal of the rejections, and formal notification of the allowability of all claims as now presented are earnestly solicited in light of the above amendments and remarks that follow.

#### **I. Co-pending Application**

Applicants wish to direct the Examiner's attention to a co-pending patent application assigned to the same assignee that also claims a filter embodiment having a divided internal compartment. The Examiner's attention is specifically directed to application Serial No. 10/675,937 and the art recited therein. Some of the art cited during prosecution of the co-pending application is already of record. An Information Disclosure Statement filed concurrently with this amendment places the remaining references in the record. The Examiner will note that the following references have been cited against the claims of the co-pending case during its prosecution: U.S. Patent Nos. 3,079,926; 3,251,365; 3,279,476; 3,603,319; 3,658,069; 2,815,760; and 5,714,126, and U.S. Publication Nos. 2002/0166563; 2004/0237984; and 2005/0139223.

#### **II. Pending Claims**

Claims 21-23, 25-39 and 41 are pending in the application. Claims 24 and 40 have been cancelled herein without prejudice or disclaimer. New claim 41 has been added. Independent claim 21 has been amended to recite that the section of fibrous tow filter material positioned proximal to the tobacco rod abuts a charge of smokable filler material in the tobacco rod. Claim 21 has also been amended to recite that both the first and second sections of fibrous tow filter material consist of plasticized fibrous tow. Additionally, Claim 21 has been amended to recite that the semi-permeable barrier consists of a porous paper or a plasticized fibrous tow. Finally, Claim 21 has been amended to recite that the plug wrap forms a wall of the compartment. Support for all of these amendments may be found throughout the specification, such as in Fig. 3, the accompanying discussion on page 18, and in Example 4. Claim 25 has been amended to retain consistency with the amendments made to claim 21. New claim 41 is substantially similar in scope to amended claim 21, with the exception that all filter segments and the semi-permeable

barrier are described as consisting of plasticized cellulose acetate tow. Additionally, claim 41 recites that the adsorbent material is in granular form. Applicants respectfully submit that no new matter is introduced by these amendments.

### **III. Interview Summary**

Applicants appreciate the time and attention of the Examiner in an interview held on June 23, 2009. During the interview, the obviousness rejections were discussed in conjunction with claim amendments substantially similar to the claim amendments presented with this amendment. Applicants' representative discussed various distinctions between the amended claims and the cited art. In particular, the undersigned noted that the Zhuang sorbent segments cannot be viewed as consisting of plasticized fibrous tow materials. Further, the undersigned argued that the Modified Counts Filter does not provide a plug wrap that forms a boundary of the internal filter compartment. Still further, the undersigned argued that the Modified Counts Filter does not include a fibrous tow material abutting a smokable filler material, and instead requires a void space and a second free-flow filter 74 between the filter element and the tobacco plug 80. The Examiner noted that these arguments would be considered.

### **IV. Section 112 Rejection**

Claims 24 and 40 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Although Applicants do not acquiesce to this rejection, in order to expedite prosecution, claims 24 and 40 have been cancelled without prejudice or disclaimer. Accordingly, this rejection is now moot and Applicants respectfully request reconsideration of withdrawal thereof.

### **V. Obviousness Rejections**

Claims 21 and 24-40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the previously-recited Counts, Zhuang, Yang, and Keith references. Similarly, Claims 22 and 23 stand rejected over the same combination of references, further in view of U.S. Patent No. 4,564,030 to Jessup et al. In both rejections, the Examiner relies upon the combined references as teaching a Modified Counts Filter, which was the subject of an appeal. The Examiner opines

that the filter element in the Counts reference abuts a tobacco rod, if the tobacco rod is viewed as including the void space 91 and free-flow filter 74. The Examiner also opines that the previous claims could be construed as only requiring a lack of the Yang adsorbent in the fibrous tow filter segments. Finally, the Examiner also noted that recitation in the previous version of claim 21 directed to the plug wrap defining the compartment also fails to distinguish from the Modified Counts Filter. Applicants respectfully traverse these rejections.

To establish a *prima facie* case of obviousness, according to a test predominately used by the courts, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim elements. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

With regard to the Supreme Court's decision in *KSR Int'l. Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007), it is noted that the Court did not dismiss the usefulness the well-established "teaching, suggestion, or motivation" test set forth above, but merely cautioned against its rigid application. The Supreme Court in *KSR* commented that the Federal Circuit "no doubt has applied the test in accord with these principles [set forth in *KSR*] in many cases." *Id.* 82 USPQ2d at 1396. However, the Supreme Court also opined that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results. . ." *Id.* 82 USPQ2d at 1395-96. Regardless of the precise test used, the Court, quoting *In re Kahn*, cautioned that " '[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.' " *Id.* 82 USPQ2d at 1396.

Applicants respectfully submit that there are numerous structural distinctions between the claimed invention and the Modified Counts Filter relied upon by the Examiner in all obviousness rejections. First, Applicants note that both independent claims 21 and 41 recite that a fibrous tow filter segment abuts a charge of smokable filler material of a tobacco rod. As noted above, the

language of claim 21 has been amended to clarify that the abutting contact is not merely between the fibrous tow filter material and a broadly-defined "tobacco rod," but instead refers to abutting contact with a charge of smokable filler material. The Examiner construed the previous claim language referring to abutting contact with a tobacco rod as failing to distinguish from the Counts patent because the Examiner was construing the tobacco rod of the Counts patent as including the void region and the free-flow filter positioned therein. The claims now recite that the fibrous tow filter material of the filter element is abutting a charge of smokeable filler material, which is clearly structurally distinguishable from the Counts patent. In particular, the Examiner's attention is directed to Fig. 4a of the Counts patent, which clearly illustrates a void region 91 and a free-flow filter element 74 between the filter element and the tobacco plug 80. The Counts patent teaches that the void 91 is necessary to prevent heating of the free-flow 74 during smoking. See column 11, lines 36-40. Additionally, the Counts patent teaches that the free-flow filter 74 provides structural definition and support for the tobacco rod and permits aerosol to be withdrawn from the tobacco rod with a minimum tobacco pressure drop. The patent also notes that the free-flow filter acts as a flow constriction at the end of the tobacco rod, which is believed to help promote formation of aerosol during draw. See column 9, lines 11-18. In contrast, all claims of the present invention recite a fibrous tow filter material abutting a charge of smokable filler material. This language clearly distinguishes from the Counts patent, which requires a sizeable distance between a charge of smokable filler material and any section of a filter element.

In addition, Applicants note that all claims of record recite that the plug wrap encompassing the filter element forms a wall of the compartment. Again, this is clearly a structural distinction from the Modified Counts Filter. The Modified Counts Filter, as explained by the Examiner, involves placing carbon from the Yang patent within the free-flow element 102. Accordingly, the analogous compartment of the modified Counts filter has a wall formed from the free-flow filter rather than plug wrap.

Still further, Applicants note that all claims of record recite that both sections of fibrous tow filter material consist of plasticized fibrous tow. Similarly, claim 21 recites that the semi-permeable barrier consists of porous paper or a plasticized fibrous tow. Claim 41 recites that both filters segments and the semi-permeable barrier consist of plasticized cellulose acetate tow.

This provides another clear structural distinction from the Modified Counts Filter relied upon by the Examiner. During the appeal process, the Examiner opined that the Zhuang reference can be viewed as suggesting an adsorbent segment that comprises activated carbon, but which does not necessarily exclude the presence of conventional filter materials in its construction. See Examiner's Answer, page 20. Accordingly, in the rejection, the Zhuang patent is considered to be suggestive of the use of a fibrous tow incorporating a carbon material. The clear language of the presently-amended claims recites that the fibrous tow filter elements and the semi-permeable barrier consist of plasticized fibrous tow materials or, or in the case of the barrier, a porous paper. Accordingly, a fibrous tow incorporating carbon is excluded from the scope of the claim.

As outlined above, there are numerous structural distinctions between the art cited in the present application and the claimed invention. Accordingly, it is respectfully submitted that all claims are patentably distinct from the Modified Counts Filter relied upon in all obviousness rejections of record. Applicants respectfully request reconsideration and withdrawal of all obviousness rejections.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

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